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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO.       |
|--|-------------|----------------------|---------------------------|------------------------|
| 10/668,188   | 09/24/2003  | Jay A. Jupiter       | 16232-002001              | 4123                   |
| 27890  | 7590        | 05/03/2007           |                           |                        |
| STEPTOE & JOHNSON LLP<br>1330 CONNECTICUT AVENUE, N.W.<br>WASHINGTON, DC 20036 |             |                      | EXAMINER<br>SHIBRU, HELEN |                        |
|  |             |                      | ART UNIT<br>2621          | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>05/03/2007   | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/668,188

Applicant(s)

JUPITER, JAY A.

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/11/2006, 09/30/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Drawings***

1. The drawing is objected to under 37 CFR 1.83(a) because it fails to show the exact elements of the apparatus that they belong to as described in the specification, and the figure is unlighted. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishii (US Pat. No. 5,265,083).

Regarding claim 1, Ishii discloses a portable digital image viewer comprising: a compact disc reader configured to read a digital image file from a compact disc (see fig. 2, col. 3 lines 41-47 and col. 5 lines 48-55); and an integrated display screen configured to display a still image from the digital image file (see abstract, col. 7 lines 14-30 and col. 9 lines 8-20).

Regarding claim 2, Ishii discloses a base including the compact disc reader (see fig. 2-4, component 2).

Regarding claim 3, Ishii discloses a lid including the integrated display screen, the lid being attached to the base by a hinge and swinging between an open position and a closed position, wherein the lid encloses a compact disc (see abstract, col. 3 lines 54-61 and col. 5 lines 6-28).

Regarding claim 4, Ishii discloses one or more control keys mounted on the base or on the lid and operably connected to the compact disc reader (see col. 3 lines 49-53, col. 10 lines 1-9, and figs 3 and 6).

Regarding claim 5, Ishii discloses a control key is configured to advance a first still image displayed on the screen to a second still image (see col. 10 lines 1-9).

Regarding claim 6, Ishii discloses the integrated display screen is a color screen (see col. 7 lines 14-30).

Regarding claim 7, Ishii discloses the color screen has a diagonal dimension of no more than 6 inches (see col. 5 lines 36-41, where it shows the screen is 4 inches).

Regarding claim 8, Ishii discloses the compact disc reader includes a laser that operates at a wavelength longer than 750 nm (see col. 8 lines 10-28 where it teaches a semiconductor laser is used, and it is inherent that semiconductor laser emits wavelength above 750nm).

**Note to the Applicant:** The USPTO considers the Applicant's "or" language to be anticipated by any reference containing one of the subsequent corresponding elements.

Regarding claim 9, Ishii discloses the digital image file is a JPEG, GIF, TIFF or bitmap file and the controller is configured to decode the digital image file for display on the integrated display screen (see col. 1 lines 12-20, col. 7 lines 14-30 and fig. 11).

Regarding claim 10, the limitation of claim 10 can be found in claims 1 and 8. Therefore claim 10 is analyzed and rejected for the same reason as discussed in claims 1 and 8 above.

Claims 11-13 are rejected for the same reason as discussed in claims 2-4 respectively above.

Regarding claim 15, Ishii discloses the viewer is configured to display a digital image at full size on the integrated display screen (see col. 7 lines 14-30).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14, 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii.

Regarding claim 14, claim 14 differs from Ishii in that the claim further requires to display the one or more images as a thumbnail. Official Notice is taken that displaying an image

as a thumbnail is well known in the art in order to represent the image in smaller size. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to display a thumbnail image for the users to search data.

Regarding claim 16, Ishii discloses a portable digital image viewer comprising: a compact disc reader configured to read a digital image file from a compact disc (see rejection of claim 1 above); and an integrated display screen configured to display a still image from the digital image file (see rejection of claim 1 above).

Claim 16 differs from Ishii in that the claim further requires an input port for a digital memory card configured to read a digital image file from a digital memory card. Although Ishii does not specifically disclose in the detailed description, Ishii discloses using a joy card in the conventional CD\_I system. Official Notice is taken that using a digital memory card in a portable image viewer is well known in the art in order to save data. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an input port for a digital memory card in order to connect a removable memory.

Claims 17-19 are rejected for the same reason as discussed in claims 2-4 respectively above.

Claims 20-21 are rejected for the same reason as discussed in claims 14-15 respectively above.

Claim 22 is rejected for the same reason as discussed in claim 8 above.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aruga et al. (US Pat. No. 6,429,896) discloses memory card.

Schiller et al. (US Pat. No. 6,442,573) discloses memory card and thumbnail image.

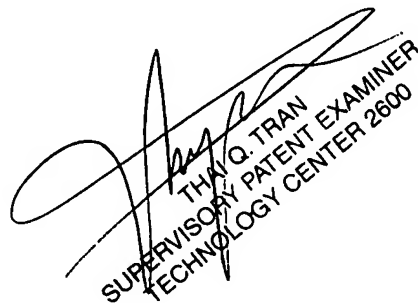
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329.

The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru  
April 23, 2007



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